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JEFFREY S. SHARP
MARSHALL, GERSTEIN AND BORUN
6300 SEARS TOWER
233 SOUTH WACKER DRIVE
CHICAGO IL 60606-6357

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APR 16 2009

In re Application of	:	OFFICE OF PETITIONS
Conway et al.	:	
Application No. 09/889085	:	
Filing or 371(c) Date: 01/09/2002	:	DECISION
Attorney Docket Number: 28053/38258	:	ON PETITION

This is a decision on the "Petition Under 37 CFR 1.182 and Request for Withdrawal of Holding of Abandonment and Request to re-Open Prosecution," filed February 3, 2009. The petition is properly treated as a petition to withdraw the holding of abandonment under 37 CFR § 1.181 (no fee).

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed May 31, 2005, wherein no claims were allowed. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a).

Applicant filed a Notice of Appeal in response to the Office action on October 3, 2005, and an Appeal Brief on March 3, 2006. The Examiner filed an Answer on May 2, 2006, and Applicant filed a Reply Brief on July 5, 2006. The case was set before the Board of patent Appeals and interferences ("Board"), which affirmed the Examiner in a Decision mailed December 29, 2006. A Notice of Abandonment was mailed March 14, 2007.

The April 16, 2007 Petition

Applicant filed a petition on April 16, 2007 wherein Applicant asserted that a timely Amendment of the rejected claims was filed in response to the Board Decision, under the provisions of 37 CFR 1.8 on February 28, 2007. In support of this assertion, Applicant filed a copy of the reply.

Office records

A review of Office records revealed that the Office received an "Amendment and Request to Reopen Prosecution Under 37 CFR Section 41.50," (hereinafter 'Amendment'), on March 5, 2007. A review of the Transmittal Form filed with the Amendment reveals that the Transmittal Form contains a Certificate of Mailing under 37 CFR 1.8(a), dated February 28, 2007, executed by Petitioner.

Decision granting the petition

A decision granting the petition to withdraw the holding of abandonment was mailed June 2, 2008. The application was referred to the Technology Center for processing of the amendment.

Notice of Abandonment

This Office mailed a Notice of Abandonment on October 7, 2008. No Office action in response to the Amendment was issued. The Examiner noted in the Notice of Abandonment that the amendment was not entered because prosecution is closed and the amendment was not suggested in an explicit statement by the Board in accordance with 41.50(c).

Analysis

A review of the Board's Decision reveals that the Board issued a Decision Affirming the Examiner, but entering a new ground of rejection pursuant to 41.50(b), and giving the applicant the option of re-opening prosecution or requesting rehearing (Board Decision of 12-29-06) (Emphasis supplied).

37 CFR 41.50(c) states that "The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. When the opinion of the Board includes such a statement, appellant has the right to amend in conformity therewith."

However, the Board entered a new ground of rejection pursuant to 41.50(b), which says

Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

The options are reopen prosecution, or request rehearing. An Applicant may reopen prosecution by

[s]ubmit[ting] an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

Applicant timely filed an Amendment on March 5, 2007 (Certificate of Mailing dated February 2, 2008).

Conclusion

In view of the foregoing, the petition is granted. The holding of abandonment is hereby withdrawn.

The petition fee has been refunded to Applicant's deposit account as authorized in the present petition.

The application will be referred to Technology Center Art Unit 1657 for processing of the Amendment, and for continued examination in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions